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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/281,813	03/31/1999	STEPHEN PALM	P17243	7668

7055 7590 12/07/2001

GREENBLUM & BERNSTEIN, P.L.C.  
1941 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

NGUYEN, DUNG X

ART UNIT	PAPER NUMBER
2631	

DATE MAILED: 12/07/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)			
	09/281,813	PALM, STEPHEN			
	Examiner Dung X Nguyen	Art Unit 2631			
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --					
<p><b>Period for Reply</b></p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>					
<p><b>Status</b></p> <p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>application dated 31 March 1999</u>.</p> <p>2a)<input type="checkbox"/> This action is <b>FINAL</b>.      2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>					
<p><b>Disposition of Claims</b></p> <p>4)<input checked="" type="checkbox"/> Claim(s) <u>1 - 41</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input type="checkbox"/> Claim(s) _____ is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input checked="" type="checkbox"/> Claim(s) <u>1 - 41</u> are subject to restriction and/or election requirement.</p>					
<p><b>Application Papers</b></p> <p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11)<input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner.</p> <p style="margin-left: 20px;">If approved, corrected drawings are required in reply to this Office action.</p> <p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>					
<p><b>Priority under 35 U.S.C. §§ 119 and 120</b></p> <p>13)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p style="margin-left: 20px;">1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p style="margin-left: 20px;">2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p style="margin-left: 20px;">3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p style="margin-left: 20px;">* See the attached detailed Office action for a list of the certified copies not received.</p>					
<p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).</p> <p>a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>					
<p><b>Attachment(s)</b></p> <table style="width: 100%; border: none;"> <tr> <td style="width: 50%; vertical-align: top;">           1) <input type="checkbox"/> Notice of References Cited (PTO-892)            2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)            3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____         </td> <td style="width: 50%; vertical-align: top;">           4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____            5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            6) <input type="checkbox"/> Other: _____         </td> </tr> </table>				1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 - 10, and 31 - 38, drawn to method for establishing a communication link by selecting an appropriate mode and executing the initialization procedure, classified in class 375, subclass 222.
  - II. Claims 11 - 22, drawn to a method for testing characteristics of communication system, classified in class 375, subclass 224.
  - III. Claims 23 - 30, drawn to a communication device with carrier determination (selecting carriers) based on pre-determined carrier reduction system, classified in class 375, subclass 260.
  - IV. Claims 39 - 41, drawn to a communication device for configuring & performing handshake, classified in class 709, subclass 228.
3. Inventions I - VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are selecting a device (claims 1 - 10, and 31 - 38), which does not need the information of neither testing device for exchanging data (claims 11 - 22), nor determining carriers based on pre-determined carrier reduction system transmitting predetermined carriers (claims 23 - 30), and nor configuring handshake communication parameters (claims 39 - 41).
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and by recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. Furthermore, this application contains claims directed to the following patentably distinct species of the claimed invention: group I classified in class 375, subclass 222.

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, group I classified in class 375, subclass 222 including claims 1 – 10 drawing to a selecting device, which does not need the information of neither claims 31 – 34 drawing to a selecting fall back procedure based on devices not able to process un-modulated carriers, nor claims 35 – 36 drawing to a selecting communication modes based on capability lists, and nor claims 37 – 38 drawing to an executing negotiation to select embedded operation channel. No claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Contact Information***

9. Any response to this action should be mailed to:

**Assistant Commissioner for Patents**

Washington, DC 20231

Or fax to:

(703) 308-9051 or (703) 308-9052 (for formal communications intended for entry), or  
(703) 306-5406 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

10. Hand-delivered responses should be brought to:

Crystal Park II

2121 Crystal Drive

Arlington, VA, Sixth floor (Receptionist)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung X. Nguyen whose telephone number is (703) 305-4892. The examiner can normally be reached on Monday through Friday from 10:00 am to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Chi Pham can be reached on (703) 308-4378. The fax phone numbers for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305- 4700.

DXN  
December 04, 2001

  
CHI PHAM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600  
12/04/01